

Inventor : Gordon et al.
Serial No. : 09/868,356
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REMARKS

This amendment is responsive to the Final Office Action (hereinafter referred to as "the Final Action") mailed May 24, 2005. Claims 1-16 and 19-21 are under examination in the present action. Claims 3, 4, 6, 8 and 11 are listed as withdrawn from consideration. Claims 1, 2, 15, 16, 20 and 21 stand rejected. Claims 5, 7, 9, 10, 12-14 and 19 are listed as objected to.

Claims 3, 4, 6, 8 and 11 have been canceled without waiver or prejudice. Applicants expressly reserve the right to reintroduce said canceled claims into the above-referenced application in the event that an allowance is not secured and/or file a new application at a later date directed to the canceled claims.

Claim 1 has been amended as indicated above. The Applicants state that neither the amendment of claim 1 nor the cancellation of claims 3, 4, 6, 8 and 11 introduce new matter. In addition, Applicants attest that the amended claims set does not require a change of inventorship pursuant to 37 C.F.R. 1.48(b). No new claim has been added.

1. Applicants are grateful for the withdrawal of "the improper Markush rejection" of claims 1, 2, 5, 7, 15, 16, 20 and 21 and as detailed in the paragraph identified as "4)" in the Office Action mailed August 31, 2004.

2. Applicants are grateful for the withdrawal of the 35 U.S.C. §112, second paragraph, rejection of claims 1, 2,

15, 16, 20 and 21 as detailed in the paragraphs identified as "5b), 5c), 5d) and 5e)" in the Office Action mailed August 31, 2004.

3. The rejection of claims 1, 2, 15, 16, 20 and 21 under 35 U.S.C. §112, second paragraph, for being vague and indefinite due to an inconsistency between the definitions of R⁶ and R⁷ and the proviso clauses appended to claim 1 has been maintained. In their response to the Office Action mailed August 31, 2004, Applicants restricted the definition of R⁶ to H or an aryl substituted with X¹, X² and X³ and further restricted the definition of R⁷ to =O, H, =S or an aryl substituted with X¹, X² and X³ arguing that this amendment removed the noted inconsistency. In the Final Office Action, the Examiner disagreed with the Applicants arguing that "at not time is R⁶ or R⁷ an aryl." Applicants agree with the Examiner's opinion and have amended the definitions of R⁶ and R⁷ by restricting R⁶ to H and R⁷ to =O, H or =S¹. Applicants respectfully contend that the amendment of claim 1, to eliminate the possibility that either R⁶ or R⁷ is an aryl group, overcomes the rejection of claims 1, 2, 15, 16, 20 and 21 under 35 U.S.C. §112, second paragraph.

Applicants respectfully request that the rejection of claims 1, 2, 15, 16, 20 and 21 under 35 U.S.C. §112, second

¹ Claim 1 was also amended to relocate the definitions of R⁸ and R⁹ so as to follow the definition of R⁷, thus restoring numerical ordering.

paragraph, for being vague and indefinite, be reconsidered and withdrawn.

4. Applicants are grateful for the withdrawal of the rejection of claims 15 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 10 and 14 of co-pending application USSN 10/129,569.

5. In compliance with the Examiner's directive to cancel all nonelected subject matter from the instant application, claims 3, 4, 6, 8 and 11 have been canceled.

6. Claims 1, 2, 15, 16, 20 and 21 stand rejected under 35 U.S.C. §112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention at the time the application was filed had possession of the claimed invention. In particular, the Examiner states that "the definition of R⁶ where R⁶ is an aryl substituted with X¹, X² and X³ and the definition of R⁷ where R⁷ is an aryl substituted with X¹, X² and X³" wherein "X¹, X² and X³ are H, halogen, NO₂, NHCOR⁸, CN or CON(R⁸R⁹)" is unsupported in the specification which clearly states that R⁶ and R⁷ can only be substituted with "OH, (C₁₋₆)alkyl, (C₁₋₆)alkoxy, N(R⁸R⁹), COOH, CON(R⁸R⁹) or halo." Applicants agree with the Examiner and are of the opinion that the above-described amendment of claim 1 in response to the 112 rejection, wherein both R⁶ and R⁶ can no

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longer be substituted with either one of X^1 , X^2 or X^3 , effectively obviates this rejection.

Applicants respectfully request that claims 1, 2, 15, 16, 20 and 21, rejected under 35 U.S.C. §112, first paragraph for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention at the time the application was filed had possession of the claimed invention, be reconsidered and withdrawn.

7. Claims 5, 7, 9, 10, 12-14 and 19 have been objected to for being dependent upon a rejected base claim. Applicants are grateful for the Examiner's invitation to rewrite the objected to claims in independent form including all of the limitations of the base claim and any inverting claims. It is Applicants' opinion, however, that the amendment of claim 1, as indicated above, places independent claim 1, upon which claims 5, 7, 9, 10, 12-14 and 19 are ultimately dependent thereon, in a condition for allowance, thus obviating the need to amend said claims as suggested by the Examiner. The Applicants, however, respectfully request a second opportunity to amend the objected to claims in the event that the Examiner disagrees with the Applicants and maintains the rejection of independent claim 1.

Applicants respectfully submit that all pending claims are in a condition for allowance. Reconsideration of the Final Office Action, entry of the amendments submitted

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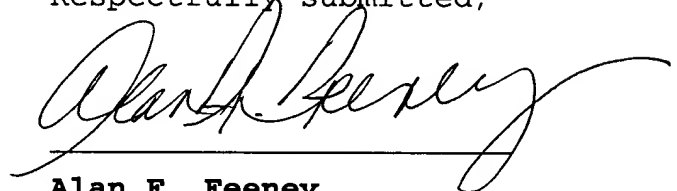
herewith and allowance of all pending claims are respectfully requested. Prompt and favorable action is solicited.

Examiner Coleman is invited to telephone Applicants' attorney at (508) 478-0144 to facilitate prosecution of this application. Please apply any charges or credits to Deposit Account No. 50-0590 referencing attorney docket number 084/US/PCT2/US.

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Respectfully submitted,



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